

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Attorney Docket No. 038441/0104

In re Patent Application of

Robert W. KILLICK et al.

Serial No. 09/831,301

Group Art Unit: 1616

Filed: May 8, 2001

Examiner: A. Pryor

For: ADJUVANT COMPOSITION FOR CHEMICALS USED IN AGRICULTURE

**REPLY AND AMENDMENT
UNDER 37 C.F.R. §1.111**

Commissioner for Patents
Washington, D.C. 20231

Sir:

In reply to the Office Action mailed July 30, 2001, please amend the application and reconsider the claims in view of the following remarks.

IN THE CLAIMS

Please cancel claim 31 without prejudice or disclaimer.

REMARKS

Applicants have carefully reviewed the Office Action of July 30, 2001. The present Amendment is intended to be fully responsive to all points of rejection raised by the Examiner and is believed to place the application in condition for allowance. Favorable reconsideration and allowance of the application are respectfully requested.

Status of the Claims

Claim 31 has been canceled without prejudice or disclaimer. The cancellation of claim 31 does not constitute acquiescence in the propriety of any rejection set forth by the Examiner. Applicants appreciate that the Examiner has indicated that claim 33 is allowable and that claims 5-10, 12-14, 17, 21, 23, 25, 26, 34-38 and 41-45 are free of

the prior art, but are objected to, for depending from a rejected base claim. Claims 1-30 and 32-45 are pending in this application.

Duplicate Claim Warning

The Examiner has asserted that should claim 1 be found allowable, claim 30 would be rejected as a substantial duplicate of claim 1. Applicants respectfully disagree. It is respectfully submitted that claim 30 is not a substantial duplicate of claim 1. Rather, claim 30 requires not only the lipophilic solvent, lipophobic plant nutrient and the cationic emulsifier of claim 1, but also recites a "chemical used in agriculture." Therefore, claim 30 is not a substantial duplicate of claim 1. It is requested that the Examiner reconsider his position on this point.

Inasmuch as claim 31 is substantially identical to claim 1, claim 31 has been canceled. It is assumed that the Examiner's "duplicate claim warning" was intended to apply to claim 31 – rather than claim 30 – and that the confusion resulted from a typographical error.

Claim Rejections based on 35 U.S.C. § 103(a)

The Examiner has rejected claims 1-4, 11, 15, 16, 18-20, 22, 24, 27-32, 39 and 40 under 35 U.S.C. § 103(a) as allegedly unpatentable over Saphakkul (U.S. Patent No. 4,964,874, hereafter "Saphakkul") and JP 59023898 (abstract). Applicants respectfully traverse.

The Examiner asserts that Saphakkul discloses a fatty alcohol and an alkyl quaternary ammonium chloride thereby allegedly meeting element (a), a lipophilic solvent, and element (c), a cationic emulsifier, of the presently claimed invention. The Examiner relies on the JP patent abstract to teach ammonium chloride, thereby allegedly meeting element (b), a lipophobic plant nutrient, of the present invention. The Examiner's motivation rests in the common utility of the disclosed compositions as hair treatments.

Applicants assert that the Examiner has failed to establish a *prima facie* case of obviousness because all three of the criteria required to establish a *prima facie* case of

obviousness have not been met. In order to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art references (or references when combined) must teach or suggest all the claim limitations. See MPEP 2142. Here, the Examiner has failed to meet all three. First, there is no motivation to modify Saphakkul. Second, the Examiner has failed to show what would constitute a “reasonable expectation of success” were the references to be combined. Lastly, the prior art cited fails to teach or suggest all the claim limitations.

In order to modify a base reference, there must be some teaching or suggestion in the prior art to do so. In fact, the Federal Circuit stated “[t]he question is . . . whether it would have been obvious from a fair reading of the prior art reference as a whole to . . . [modify the reference] . . . The mere fact that the prior art could be modified would not have made the modification obvious unless the prior art suggested the desirability of the modification.” *In re Gordon*, 221 USPQ 1121, 1127 (Fed. Cir. 1984). Here, the Examiner has pointed to no deficiency in Saphakkul or suggestion that the addition of a “lipophobic plant nutrient” would be advantageous.

It is respectfully submitted that the Examiner has failed to provide a reference or combination of references which teach or suggest each and every element of the claimed invention. Specifically, the claims recite that “the cationic emulsifier acts a coupling agent between the lipophilic solvent and the lipophobic plant nutrient to form a homogeneous liquid composition.” The Examiner has not addressed this element of the claimed invention. It is Applicants’ position that Saphakkul cannot teach or suggest this element. In fact, Saphakkul actually teaches away from a homogeneous liquid composition. Specifically, Saphakkul discloses that the cationic surfactant is present in the form of a disperse lamellar liquid crystal phase. This is clearly indicative that the final composition of Saphakkul is not a homogeneous liquid composition as required by the claims. The JP patent abstract does not remedy this deficiency. In fact, the JP patent abstract fails to teach or suggest a cationic emulsifier, rather, the reference merely discloses a “surfactant” and

fails to provide any suggestion that a cationic emulsifier acts as a coupling agent between the lipophilic solvent and the lipophobic plant nutrient. Thus, alone and in combination, the cited prior art fails to meet this element of the claimed invention.

Moreover, it is respectfully submitted that the Examiner has arbitrarily combined Saphakkul with the JP patent abstract to arrive at the present invention by the use of impermissible hindsight. Applicants understand that "[a]ny judgement on obviousness is in a sense necessarily a reconstruction based on hindsight reasoning, but so long as it takes into account only knowledge which was within the level of ordinary skill in the art at the time the claimed invention was made and does not include knowledge gleaned only from applicant's disclosure, such a reconstruction is proper." *In re McLaughlin*, 443 F.2d 1392, 1395, 170 USPQ 209, 212 (CCPA 1971). However, picking and choosing substances from different prior art references, as is the case here, to arrive at the present invention, constitutes impermissible hindsight. Accordingly, a proper *prima facie* case of obviousness has not been established.

In addition, claims 18-20, 22, 24, 27-30, 32, 39 and 40 are further patentable over the cited prior art for the following deficiencies in the references as applicable to each claim enumerated.

Claim 18 is further patentable over the cited references because there is no teaching or suggestion of an additional component in the composition to improve the form of the composition.

Similarly, claims 19 and 20 are further patentable because of the lack of teaching of an additional component in the composition to improve the form of the composition which is selected from nonionic emulsifiers, co-solvents and mixtures thereof (claim 19) or which is one or more nonionic emulsifiers (claim 20).

Claim 22 is further patentable over the cited references because neither reference teaches or suggest the use of a co-solvent.

Claim 24 is further patentable over the cited references because claim 24 depends from claim 6, which recites that the petroleum fraction of the liophilic solvent is a

mineral oil. This is not taught nor suggest by any of the prior art. In fact, the Examiner has indicated that claim 6 is free of the prior art.

Claims 27-28 recite a mixture of cationic emulsifiers. Neither Saphakkul nor the JP patent abstract teach or suggest a mixture of cationic emulsifiers.

Claim 30 also is not taught by the cited references. Particularly, claim 30 requires a "chemical used in agriculture." This element is not taught by the prior art hair treatment compositions.

Similarly, claim 32 is further patentable over the cited references because the claim recites a method for enhancing the activity of a "chemical used in agriculture." Neither prior art reference directed to hair treatment compositions can teach or suggest this method.

Lastly, claims 39 and 40 recite an additional component of the composition, the component is to improve the form of the composition. There is not teaching or suggestion of this claim element in the cited references. Specifically, with respect to claim 40, there is no teaching of an additional component in the composition to improve the form of the composition which is selected from nonionic emulsifiers, co-solvents and mixtures thereof.

For the above reasons, the Examiner has failed to establish a proper *prima facie* case of obviousness. Accordingly, reconsideration and withdrawal of the rejection are respectfully requested.

Conclusion

For the foregoing reasons, the rejections should be withdrawn, and claims 1-30 and 32-45 should be allowed. Early and favorable action in that regard is earnestly solicited.

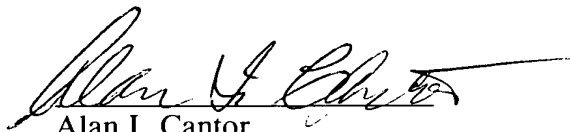
Should the Examiner have any questions concerning this Amendment, or wish to discuss any other issues in an effort to advance the prosecution of this application to issue, the Examiner is requested to contact the undersigned at the telephone number below.

Respectfully submitted,

OCT 25 2001

Date

FOLEY & LARDNER
3000 K Street, N.W., Suite 500
Washington, DC 20007-5109
(202) 672-5300



Alan I. Cantor

Registration No. 28,163

SHOULD ADDITIONAL FEES BE NECESSARY IN CONNECTION WITH THE FILING OF THIS PAPER, OR IF A PETITION FOR EXTENSION OF TIME IS REQUIRED FOR TIMELY ACCEPTANCE OF SAME, THE COMMISSIONER IS HEREBY AUTHORIZED TO CHARGE DEPOSIT ACCOUNT NO. 19-0741 FOR ANY SUCH FEES; AND APPLICANT(S) HEREBY PETITION FOR ANY NEEDED EXTENSION OF TIME.